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PTO/SB/21 (08-03)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

26

Application Number 10/010,667

Filing Date December 6, 2001

First Named Inventor Daniel E. H. AFAR

Art Unit 1642

Examiner Name G. Nickol, Ph.D.

Attorney Docket Number 511582001621

ENCLOSURES (Check all that apply)

☒ Fee Transmittal Form

☐ Fee Attached

☒ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☒ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/ Incomplete Application

☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ After Allowance Communication to Group

☐ Appeal Communication to Board of Appeals and Interferences

☐ Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please identify below):

Copy of Restriction Requirement from Parent Case (7 pages)

Copy of Japanese Reference JP11/164691 (3 pages)

Copy of Table for Sequence Listing (1 page)

Remarks

Return Postcard

Customer Number 25225

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

MORRISON & FOERSTER LLP
Kate H. Murashige - 29,959

Signature

Kate H. Murashige

Date

October 15, 2003

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated:

10/15/03

Signature:

Tami M. Procopio

(Tami Procopio)

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003, Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)475.00

Complete if Known

Application Number 10/010,667
Filing Date December 6, 2001
First Named Inventor Daniel E. H. AFAR
Examiner Name G. Nickol, Ph.D.
Art Unit 1642
Attorney Docket No. 511582001621

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number

03-1952

Deposit Account Name

Morrison & Foerster LLP

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
	** =	x	=
Independent Claims	** =	x	=
Multiple Dependent		=	=

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	475.00
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)475.00

SUBMITTED BY

(Complete if applicable)

Name (Print/Type) Kate H. Murashige

Registration No. (Attorney/Agent) 29,959

Telephone (858) 720-5112

Signature

Kate H. Murashige

Date

October 15, 2003

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Dated: 10/15/03

Signature: *Jami M Procopio* Jami Procopio



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/323,873	06/01/99	AFAR	1703-001US1

HM12/0410

KENNETH K SHARPLES
LAW OFFICE OF KENNETH K SHARPLES
80 FOURTH STREET
P O BOX 277
POINT REYES STATION CA 94955

EXAMINER

NICKOL, G

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

04/10/00

COPY

Please find below and/or attached an Office communication concerning this application or proceeding.

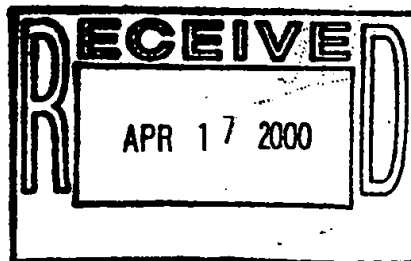
Commissioner of Patents and Trademarks

RECEIVED

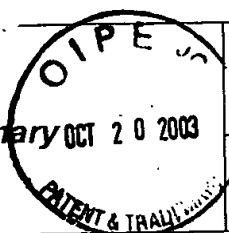
OCT 28 2003

TECH CENTER 1600/2900

COPY



Office Action Summary



Application No. 09/323,873	Applicant(s) AFAR ET AL.	
Examiner Gary B. Nickol Ph.D.	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

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Disclosure

The nucleotide and or amino acid sequences are not in compliance with the rules set forth in MPEP § 1.821. The specification and claims should identify the appropriate sequences of reference.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 9 drawn to isolated an STRAP-1 polypeptide, classified in class 530, subclass 350.
- II. Claims 10-11, drawn to an isolated STRAP-2 polypeptide, classified in class 530, subclass 350.
- III. Claims 4-8 drawn to isolated STRAP-1 polynucleotides, vectors, host cells, and methods of producing the polypeptide thereof, classified in class 536, subclass 23.1, class 435, subclasses 69.1, 320.1, and 325.
- IV. Claims 12-13 drawn to an isolated STRAP-2 polynucleotide class 536, subclass 23.1.

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- V. Claims 14-24, 30 drawn to a monoclonal antibody or fragments thereof specific for STRAP-1 polypeptide and a method of detecting said polypeptide with said antibody, classified in class 530, subclass 388.9 and class 435, subclass 7.1.
- VI. Claims 25-29,31 drawn to a conjugated monoclonal antibody specific for STRAP-2 polypeptide, and a method of detecting said polypeptide with said antibody, classified in class 530, subclass 388.1 and class 435, subclass 7.1.
- VII. Claims 32,34 drawn to an assay for detecting STRAP-1 polynucleotides comprising probes for hybridization and primers for amplification reactions, classified in class 435, subclass 91.21.
- VIII. Claims 33,35, drawn to an assay for detecting STRAP-2 polynucleotides comprising probes for hybridization and primers for amplification reactions, classified in class 435, subclass 91.21.
- IX. Claims 36-38, drawn to a composition for the treatment of cancer comprising a STRAP-1 antibody, classified in class 424, subclass 155.1.
- X. Claim 39, drawn to a composition for the treatment of prostate cancer comprising a STRAP-2 antibody, classified in class 424, subclass 155.1.

The inventions are distinct, each from the other because of the following reasons:

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The inventions of Groups I-VI and IX-X represent separate and distinct products for the following reasons:

Groups I and II, although related by gene family, represent distinctly different polymers of amino acids with different molecular weights which are functionally and chemically unrelated from the polynucleotides of Groups III-IV, the antibodies of Groups V-VI, and the pharmaceutical compositions of Group IX and X.

Groups III and IV, although related by gene family, represent distinctly different polymers of nucleic acids with different molecular weights and different translational events.

Groups V and VI, represent distinctly different proteins specific for different polypeptides comprising different antigen binding regions which further imparts different steps, reagents and outcomes in, related, but distinct assays. Furthermore, these differences are inherent in the compositions of Groups IX and X which are also composed of proteins with varying binding specificity.

The inventions of Groups V-VI and IX and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the antibodies can be used diagnostically; for example, to determine the amount of STRAP-1 protein in tissue or blood.

The inventions of Groups VII and VIII, although related, represent distinct methods comprising different reagents and resulting in distinct outcomes: Group VII is drawn to an assay

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whose outcome detects STRAP-1 polynucleotides while Group VIII is drawn to an assay for detecting STRAP-2 polynucleotides.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, because these inventions are distinct for the reasons given above and the search required for one group is not required for another group, restriction for examination purposes as indicated is proper.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 703-305-7143. The examiner can normally be reached on M-F, 8:30-5:00 P.M..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

GBN
April 5, 2000


YVONNE EYLER, Ph.D.
PRIMARY EXAMINER